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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,658	07/14/2003	Caryn Paige Rafferty	P1384	7169

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EXAMINER
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WATKO, JULIE ANNE

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/619,658

Applicant(s)

RAFFERTY, CARYN PAIGE

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date July 14, 2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
2. The information disclosure statement filed July 14, 2003, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

3. The attempt to incorporate subject matter into this application by reference to "two document disclosures (504833 & 507652)" (see page 1, lines 17-19 of the specification) is improper because Applicant has not filed a copy of any "disclosures". Furthermore, it is unclear whether said "disclosures" are published. Moreover, Applicant has not provided sufficient information for the Examiner to retrieve a publication of the "disclosure", if any.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation “strategically” in line 9. It is unclear what strategy is meant by this limitation, such that a person of ordinary skill in the art would not be able to ascertain the metes and bounds of the structure claimed.

Claims 9 and 10 depend from claim 8, and are similarly indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

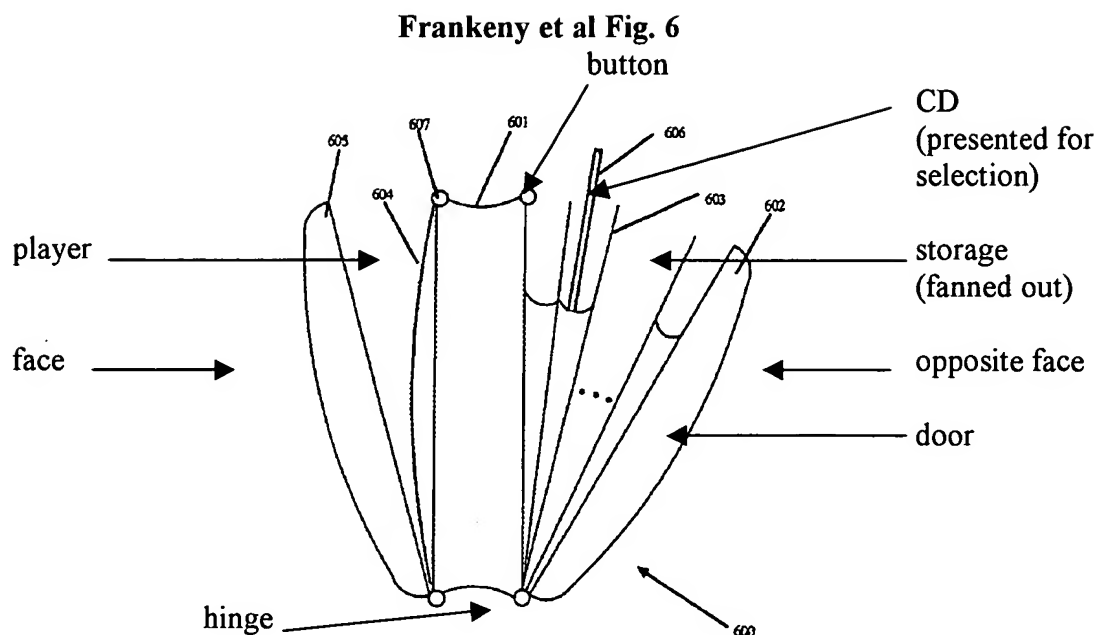
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Frankeny et al.

As recited in claim 1, Frankeny et al show a portable CD player 600 having a body 601, comprising: a first access interface 305 providing access to a CD playing apparatus 604 within the player body; and a second access interface 302 to a storage compartment also within the player body; characterized in that the storage compartment spatially supports a CD storage mechanism 603 configured to store a plurality of CD discs 606 for access and selection by a user (see Fig. 6, for example).



As recited in claim 2, Frankeny et al show a hinged door openable by a user-activated button.

As recited in claim 3, Frankeny et al show that the second access interface is located on the opposite face of the player from the face supporting the first access interface.

As recited in claim 4, Frankeny et al show that the CD storage mechanism is a collection of individual sheaths (see appearance of 603 in Fig. 6) each one capable of retaining at least one CD 606 therein, the collection thereof joined together at one end (bottom end in Fig. 6) and affixed at that end to a wall of the storage compartment.

As recited in claim 5, Frankeny et al show that the CD storage mechanism is a collection of individual sheaths each one capable of retaining at least one CD therein, the collection thereof joined together at one end and affixed at that end to the underside of the second access interface (see appearance of 603 in Fig. 6), wherein the second access interface is of the form of a openable door.

As recited in claim 7, in addition to the teachings above for claims 4 and 5, Frankeny et al show that upon opening the interface, the mechanism expands and fans out to present the CDs for selection (see Fig. 6).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

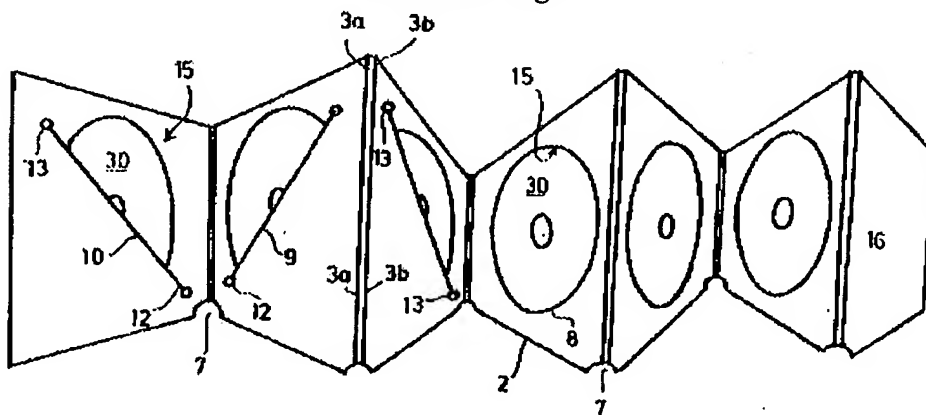
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frankeny et al (US Pat. No. 6522613 B1) in view of Bockhoff (WO 94/01866).

As recited in claim 6, Frankeny et al are silent regarding the claimed shape of storage mechanism.

As recited in claim 6, Bockhoff shows a storage mechanism in the claimed shape (see Fig. 3), wherein the storage mechanism is a foldable, elongated strip containing sequentially arranged CD sheaths each one capable of retaining at least one CD therein.

**Bockhoff Fig. 3**



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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the storage mechanism in the claimed shape. The rationale is as follows: one of ordinary skill in the art would have been motivated to arrive at the claimed shape in the course of routine design process, and to empower the user to view plural stored CDs at once.

Moreover, it is well established that a change in shape of a known product does not yield a patentable product, absent unexpected results due to the same shape. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

#### ***Allowable Subject Matter***

10. Claim 8 and its dependent claims 9-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Reasons for indicating allowable subject matter will be stated after all claims become clear and definite.

#### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ramonowski (US PAP No. 2002/0105886 A1) shows a compact disk storage comprising one positioning post 76 on one panel (see Fig. 6), and also shows CD storage compartment 32 provided in a housing 34 coupled to body 12 of CD player 10 (see Figs. 1-3). Fliegel (US Pat. No. 6574188 B1) shows a CD storage unit with plural panels and plural position-securing devices 9 (see especially Fig. 9). Tolkachev et al (US PAP No. 2004/0187143 A1) show a disc player with disc storage (see especially Figs. 7A-B; see also sliding button 72 in Fig. 5E). Segel (US Pat. No. 3104289) shows a recorder concealed in a case with storage (see especially compartment 11 in Figs. 3-4).

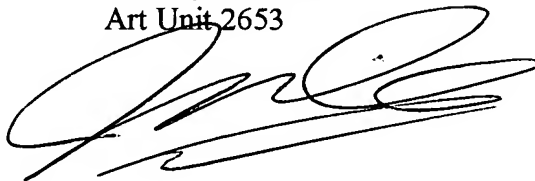
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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Tues. & Thurs. until 9PM, Wed. & Fri. until 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Julie Anne Watko  
Primary Examiner  
Art Unit 2653



March 24, 2005  
JAW